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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,554	04/15/2004	Charles Marshall	MRSH002	2105
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Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			ROSEN, NICHOLAS D	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,554

Applicant(s)

MARSHALL, CHARLES

Examiner

Nicholas D. Rosen

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 22-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/4/2004 & 11/7/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-21 have been examined (claims 22-32 are non-elected).

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, drawn to a method of web-based on-demand product manufacturing, classified in class 705, subclass 26.
- II. Claims 22-32, drawn to a method of on-site on-demand media manufacturing, classified in class 700, subclass 233.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed can have a materially different design, mode of operation, function, or effect; they do not overlap in scope and are not obvious variants, because Group I involves a website for taking orders and shipping them to customers, while Group II involves a local computing device, from which desired media items are locally manufactured and dispensed. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species: I and II. The species are independent or distinct for the reasons set forth above.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

During a telephone conversation with attorney Dominic Kotab on December 10, 2007, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-21. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-32 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

Claims 17 and 18 are objected to because of the following informalities: In the first lines of claims 17 and 18, "the product" technically lacks antecedent basis; it is taken as referring to "the media". Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 7, 8, 9, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooban (U.S. Patent 5,930,768). As per claim 1, Hooban discloses a method for earning money by web-based on-demand product manufacturing and fulfillment, comprising: hosting a website having products available for purchase (Abstract; column 3, lines 9-19; column 5, line 28, through column 6, line 4); receiving user input indicating selection of at least one of the products (Abstract; Figure 4; column 6, lines 25-42); calculating a price for the selected product (column 2, lines 60-67; column 7, lines 3-15); requesting payment information from the user (column 7, lines 11-29); receiving payment information from the user (column 7, lines 11-29); manufacturing the product (column 8, line 44, through column 9, line 3); and preparing the product for shipping to the customer (column 8, line 44, through column 9, line 3). Hooban discloses that the process can be automated to further reduce manufacturing expenses (column 4, line 52, through column 5, line 3; column 9, lines 2-3).

As per claim 2, Hooban discloses that the payment information received from the user includes credit card information (column 7, lines 11-29).

As per claim 7, Hooban discloses packaging the product in a presentation package without human intervention (column 3, lines 35-38; column 8, line 64, through column 9, line 3).

As per claim 8, Hooban discloses that the product is media (e.g., Abstract; column 4, line 52, through column 5, line 3).

As per claim 9, Hooban discloses that the media is selected from a group consisting of compact disk, digital video disk, and videotape (e.g., column 4, line 52, through column 5, line 3).

As per claim 10, Hooban discloses that user input indicates selected content to be placed on the media (Abstract; Figure 4; column 6, lines 25-42), the content being selected from a group consisting of audio, video, text, software, tables, photos, and combinations thereof (Abstract; column 6, lines 25-42; column 8, lines 44-66).

As per claim 11, Hooban discloses calculating a royalty payment for the selected content (column 2, lines 60-67; column 7, lines 3-15; column 8, lines 44-48).

Claims 12, 13, 19, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooban (U.S. Patent 5,930,768). As per claim 12, Hooban discloses a method for earning money by web-based on-demand media manufacturing and fulfillment, comprising: hosting a website having content available for purchase (Abstract; column 3, lines 9-19; column 5, line 28, through column 6, line 4); receiving user input indicating selection of some of the content (Abstract; Figure 4; column 6, lines 25-42); calculating a price for the selected content (column 2, lines 60-67; column 7, lines 3-15); requesting payment information from the user (column 7, lines 11-29); receiving payment information from the user (column 7, lines 11-29); manufacturing the media having the selected content (column 8, line 44, through column 9, line 3); and preparing the media for shipping to the customer (column 8, line 44, through column 9, line 3). Hooban discloses that the process can be automated to further reduce

manufacturing expenses (column 4, line 52, through column 5, line 3; column 9, lines 2-3).

As per claim 13, Hooban discloses that the payment information received from the user includes credit card information (column 7, lines 11-29).

As per claim 18, Hooban discloses packaging the product in a presentation package without human intervention (column 3, lines 35-38; column 8, line 64, through column 9, line 3).

As per claim 19, Hooban discloses that the media is selected from a group consisting of compact disk, digital video disk, and videotape (e.g., column 4, line 52, through column 5, line 3).

As per claim 20, Hooban discloses that the content is selected from a group consisting of audio, video, text, software, tables, photos, and combinations thereof (Abstract; column 6, lines 25-42; column 8, lines 44-66).

As per claim 21, Hooban discloses calculating a royalty payment for the selected content (column 2, lines 60-67; column 7, lines 3-15; column 8, lines 44-48).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban as applied to claim 1 above, and further in view of official notice. As per claim 3, Hooban does not disclose that the payment information received from the user includes debit card information, but official notice is taken that debit cards are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the payment information received from the user to include debit card information, for at least the obvious advantage of obtaining payments from users with debit cards.

As per claim 4, Hooban does not expressly disclose that the payment information received from the user includes online account information, although it might be considered as such, based on Hooban's disclosure of online financial transactions (column 4, lines 35-41; column 7, lines 23-29). However, official notice is taken that online accounts are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the payment information received from the user to include online account information, for at least the obvious advantage of obtaining payments from users with online accounts.

As per claim 5, Hooban discloses verifying that a user's credit card is valid (column 7, lines 20-29), which can be construed as verifying an ability of the user to pay. If, ad arguendo, this is insufficient, official notice is taken that it is well known to verify an ability of a user to pay. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to verify an

ability of the user to pay, for at least the obvious and implied advantage of not losing money by manufacturing products which will not be paid for.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban as applied to claim 1 above, and further in view of Dockes et al. (U.S. Patent 5,959,944). Hooban discloses producing packaging materials for the product, and shipping it, this being preferably accomplished by automation, without human intervention (column 3, lines 35-38; column 8, line 64, through column 9, line 3), which can be taken to imply labeling the product. Furthermore, Dockes teaches labeling a customized CD product (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to label the product without human intervention, for the obvious advantages of causing the product to be shipped to the proper destination and/or enabling the user to readily identify the particular product among others (e.g., other CD's); and to accomplish this without human intervention for the stated advantage of reducing manufacturing expenses.

Claims 14, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban as applied to claim 12 above, and further in view of official notice. As per claim 14, Hooban does not disclose that the payment information received from the user includes debit card information, but official notice is taken that debit cards are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the payment

information received from the user to include debit card information, for at least the obvious advantage of obtaining payments from users with debit cards.

As per claim 15, Hooban does not expressly disclose that the payment information received from the user includes online account information, although it might be considered as such, based on Hooban's disclosure of online financial transactions (column 4, lines 35-41; column 7, lines 23-29). However, official notice is taken that online accounts are well known. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the payment information received from the user to include online account information, for at least the obvious advantage of obtaining payments from users with online accounts.

As per claim 16, Hooban discloses verifying that a user's credit card is valid (column 7, lines 20-29), which can be construed as verifying an ability of the user to pay. If, ad arguendo, this is insufficient, official notice is taken that it is well known to verify an ability of a user to pay. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to verify an ability of the user to pay, for at least the obvious and implied advantage of not losing money by manufacturing products which will not be paid for.

Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban as applied to claim 12 above, and further in view of Dockes et al. (U.S. Patent 5,959,944). Hooban discloses producing packaging materials for the product, and shipping it, this being preferably accomplished by automation, without human intervention (column 3, lines 35-38; column 8, line 64, through column 9, line 3), which

can be taken to imply labeling the product. Furthermore, Dockes teaches labeling a customized CD product (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to label the product/media without human intervention, for the obvious advantages of causing the product to be shipped to the proper destination and/or enabling the user to readily identify the particular product/media among others (e.g., other CD's); and to accomplish this without human intervention for the stated advantage of reducing manufacturing expenses.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stonedahl (U.S. Patent Application Publication 2002/0199198) discloses a system and method for selecting, capturing, and distributing customized event recordings. Depke et al. (U.S. Patent Application Publication 2005/0210181) disclose systems and methods for the identification and/or distribution of music and other forms of useful information. Marshall (the present Applicant) (U.S. Patent Application Publication 2005/0234818) discloses an automated on-demand online media manufacturing and fulfillment system, which has been considered for possible double patenting.

Jeong (may also be spelled Jung) (Korean Patent Application Publication 2002036388-A) discloses a method for producing a CD album with a song selected by a user on the Internet.

Atwood ("Made-to-Order CDs Available on the Web") is an article describing the system and method of Hooban.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. No-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nicholas D. Rosen
NICHOLAS D. ROSEN
PRIMARY EXAMINER
December 20, 2007